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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR    | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|-------------------------|---------------------|------------------|
| 10/042,181  | 01/11/2002  | Nestor A. Bojarczuk JR. | YOR9-2000-0644      | 5965             |
| 21254   | 7590        | 11/15/2002              | EXAMINER            |                  |
| MCGINN & GIBB, PLLC<br>8321 OLD COURTHOUSE ROAD<br>SUITE 200<br>VIENNA, VA 22182-3817 |             |                         | SMITH, BRADLEY      |                  |
|   |             | ART UNIT                | PAPER NUMBER        |                  |
|   |             | 2824                    |                     |                  |
| DATE MAILED: 11/15/2002   |             |                         |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                 |                  |
|------------------------------|-----------------|------------------|
| <b>Office Action Summary</b> | Application No. | Applicant(s)     |
|                              | 10/042,181      | BOJARCZUK ET AL. |
|                              | Examiner        | Art Unit         |
|                              | Bradley K Smith | 2824             |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 15-23 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-14 and 24-30 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) 15-23 are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 29 March 2002 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
 If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
 a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: *Search notes* .

## DETAILED ACTION

### *Election/Restrictions*

1. Claims 15-23 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made without traverse in Paper No. 7.

### *Specification*

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: Rare earth metal oxide memory element based on charge storage.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 24-30 provide for the use of a hysteresis and current-voltage characteristics of a rare earth based memory element to store data, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 24-30 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper

definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966). Due to the 112 problems, claims 24-30 will not be treated with respect to the prior art.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-3, 5-8, 10 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kausik et al. (US Pregrant Publication 2002/0137317). Kausik et al. disclose a gate dielectric with a substrate comprising of a semiconductor material (12), a metal oxide layer comprising an electrically insulating rare earth metal oxide disposed on the surface of the substrate (14), a conductive material on metal oxide layer (16) and the conductive material acting as an electrode. However, with respect to claim 1, Kausik fails to disclose that a second electrode is attached to the substrate, and with respect to claim 10, Kausik fails to disclose a second and third electrode attached to the source and drain region respectively. But the examiner takes official notice that since Kausik et al. disclose that this invention is for a transistor, it would be obvious to one of ordinary skill in the art at the time the invention was made, to attach electrodes to the substrate more specifically the source and drain regions, because a solid state transistor by definition has to have electrodes attached to the source and drain in

order to function. Furthermore with respect to claims 2 , 3, 5 and 13, Kausik et al. disclose the dielectric layer comprises a mixture of lanthanum oxide and aluminum oxide. With respect to claims 6 and 7, Kausik et al. disclose the metal oxide layer has a thickness of 30-90 angstroms. With respect to claim 8, Kausik et al. disclose the conductive material comprises polysilicon.

7. Claims 4, 9, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kausik et al. (US Pregrant Publication 2002/0137317). Kausik et al. disclose the claimed invention except for the conductive material is aluminum. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use aluminum as the conductive material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

8. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kausik et al. (US Pregrant Publication 2002/0137317). Kausik et al. disclose the claimed invention except for the substrate being n-doped silicon. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use n-doped silicon, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley K Smith whose telephone number is (703) 308-6261. The examiner can normally be reached on 10-6 Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Elms can be reached on (703) 308-2816. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



MICHAEL S. LEBENTRITT  
PRIMARY EXAMINER

BKS  
November 13, 2002